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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/536,518

Filing Date: March 22, 2000

Appellant(s): NEWNAM ET AL.

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Newnam et al.  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/13/2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-16 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

"Netplay debuts Internet's premier multi-player Entertainment Network; Netplay game club brings people together to create broad-based, Online community

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-16 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 11/18/2003.

With respect to claims 1-3 , NetPlay teaches an electronic network so that multiple users can compete in a skill-based contest (entire document ). Identifying a set of contestants (see page 1, 4<sup>th</sup> paragraph); grouping the set of contestants into group subsets according to group criteria (see page 2, 3<sup>rd</sup> paragraph); matching contestants within a group subset into subcompetitions (i.e. each age group will be presented with a game according to their ages and knowledge)(page 1, paragraphs 5th and 6th); for each group subcompetition, electronically presenting a competition task (pages 1 and 2); monitoring responses to the competition task from each subcompetition and determining a subcompetition outcome status of each contestant in the subcompetition (i.e. players win points which can be redeemed for prizes)(page 2).

With respect to the contestant being a large multitude. Official notice is taken that it is old and well known to include a large number of contestants in order to make the competition more fiercely. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a large multitude of contestants in order to achieve the above mentioned advantage.

With respect to grouping at least some of the contestants according to the subcompetition outcome status and repeating the monitoring and grouping of the contestants outcome status until there is a unique winner in a fixed, short amount of time after the fixed start time. NetPlay teaches on page 1,4th paragraph that the players can become the ultimate star of the contest by playing in tournaments for additional prizes and since Netplay is computer implemented therefore the outcome of the winner to be performed in a short amount of time is obvious in order to keep excitement within the game. It is also old and well known in world series games, such as baseball and the like to repeat the monitoring of the outcome of the games and then to re-group the winners into a tournament in order to obtain the world championship winner. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included repeating the steps of monitoring and grouping the winners until there is a unique winners because such a modification would allow in the system of NetPlay for players to compete with others winners.

Claims 4, and 12 further recite enforcing a time deadline for the receipt of the response in order to consider the response as valid. Official notice is taken that it old and well known in any competition such as spelling-bee and the like to enforce a time deadline for the receipt of the response. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included enforcing a time deadline for the receipt of the responses because such a modification would allow to equally evaluate the members based on the same time frame.

The limitations of claim 5 were previously addressed in the rejection to claim 1

addressed above and therefore is rejected under similar rationale.

The limitations of claim 6 were previously addressed in the rejection to claim 4 addressed above and therefore is rejected under similar rationale.

With respect to claims 7, the limitations were previously addressed in the rejections to claims 6 and therefore rejected under similar rationale.

With respect to claims 8-11, in addition to the limitations previously addressed in the rejection to claims 6-7 addressed above, the claims further recite recording responses to create profile information, demographic and psychographic information . Official notice is taken that it is old and well known in marketing to collect information on the costumers in order to create profile, demographic and psychographic information which is often used to target advertisements and products to the customers based on their responses. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included creating profile, demographic and psychographic information with the responses collected from Netplay in order to obtain the above mentioned advantage.

With respect to claims 13-14, in addition to the limitations previously addressed in the rejections to claims 6-7 addressed above, the claims further recite that the prizes include click on electronic coupons. Netplay teaches that members are awarded prizes (page 1). Netplay is silent as to the content of the prizes. Official notice is taken that it is old and well known in marketing to award click on electronic coupons to computers

users to induce purchasing. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the prizes of Netplay to include click-on coupons in order to obtain the above mentioned advantage.

With respect to claim 15, in addition to the limitations previously addressed in the rejections to claims 6-7 addressed above, the claims further recite that the competition tasks include branded questions. Official notice is taken that it is old and well known for questions to include branded questions as part of a competition in order to test the customers knowledge on the subject. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included that the competition tasks include branded questions in order to obtain the above mentioned advantage.

With respect to claim 16, in addition to the limitations previously addressed in the rejections to claims 6-7 addressed above, the claims further recite awarding points that are redeemable for prizes. Official notice is taken that it is old and well known to award points for prizes. For example, certain retailers will award points for purchase which can be redeemed for prizes to motivate the customers to make purchases within the establishment. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included awarding points that can be redeemable for prizes in order to obtain the above mentioned advantage.

**(11) Response to Argument**

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art is presumed to have some knowledge in the art.

Appellant argues that Netplay bears no resemblance to the claimed invention, but that in fact it teaches away from the invention emphasis on rapid-fire competition-driven contests involving a large multitude. The Examiner disagrees with Appellant because Neplay teaches “**an Online, multi-player**” game (page 1, 1st paragraph). On page 10, lines 11-13 of the Appellant’s specification, it discloses “multiple users”. The specification or claim do not disclose a specific number of players. The definition of multiple is “something in units of more than two”, even assuming arguendo, changing the size is obvious. See *In re Rose*, 105 USPQ 237, 240; 220 F2d 459 (CCPA 1955). The Netplay is an Online game and therefore it is **capable** of involving a large number of Players.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, since the Netplay article is an Online multi-player game in which winners are involved in a tournament to win prizes and therefore involving a large number of contestants and declaring the winner within a short period of time is within the scope of one of ordinary skill in the art.

Appellant argues that Netplay doesn't teach the capacity to engage a large multitude in a simultaneous competition within a short time. The Examiner disagrees with Appellant because Netplay clearly teaches a tournament in which players are eligible for prizes (page 1, paragraph IV). A tournament in itself is a competition which produces a winner. A "short period" is a relative term and it doesn't imply an absolute time frame. In addition, since Netplay is an Online, Internet based game it is therefore capable of producing a winner within a short period of time. In addition, Netplay teaches on page 1, paragraph III that the players can chat and socialize while Online which means that the players are playing simultaneously.

Appellant argues that the Netplay article teaches away from the rapid-fire, massive multi-player contest. The Examiner disagrees with Appellant because although Netplay allows the members to chat and socialize while they play, it doesn't necessarily

say that they have to chat and socialize while they play but rather that the option is available. The Examiner wants to point out that since Netplay is a an Online multi-player game then it is **capable** of producing a rapid multi-player contest.

Appellant argues that Netplay doesn't teach matching contestants within a group subset into subcompetitions. The Examiner disagrees with Appellant because the claim recites "grouping at least some of the contestants according to at least one of the group criteria **or** subcompetition outcome status" since, there is an OR in the claim, the claim can be interpret as grouping the contestants according to some criteria. The criteria of grouping the contestant can be the same criteria that the contestants were grouped to begin with, which is based their skill levels as taught by NetPlay (see page 1, paragraph I).

Appellant argues the Official Notice taken by examiner that increasing the number of players to make the competition more fierce. Netplay is an online multi-player trivia tournament (page 1, paragraph VI) and therefore increasing the number of players will make the game more challenging or fiercely.

The examiner reviewed the declaration and the articles presented by the Applicant. The Examiner wants to point out that the claims were not and are not rejected under 102. The claims were instead rejected under 103 and the modifications to the claims were considered to be within the level of one of ordinary skill in the art.

Appellant argues that Netplay doesn't suggest that the winner is declared in a

short period of time because Netplay allows the players to see and chat with other players. The Examiner wants to point out that although Netplay allows the members to chat and socialize while they play, it doesn't necessarily mean that they have to chat and socialize while they play but rather that the option is available. The Examiner wants to point out that since Netplay is an Online multi-player game then it is **capable** of producing a rapid multi-player contest.

Appellant argues that declaring a winner within a short period of time does not build excitement. The Examiner disagrees with Appellant because ending a game and declaring a winner within a short period of time will motivate other players to play or for the same players to engage in further games because they will know that the games will not consume too much of their time.

Appellant argues that the Examiner didn't address time-stamping. The Examiner disagrees with Appellant because the Examiner clearly addresses that time-stamping is old and well known such as spelling-bee competition to enforce a time deadline among the participants. In addition, the Examiner is citing a reference to further show support for the official notice. Schneier et al. (5,970,143 hereinafter Schneier) teaches on col. 39, lines 38-47, time-stamping the players of a skill tournament.

Appellant argues that the Examiner didn't address that the subcompetition outcome status includes at least the states of win, lose and tie. The claim is met if at least it includes one of the limitation of win, lose or tie. In this case, Netplay teaches

declaring a unique winner and therefore a unique winner implies that the outcome status includes a win.

With respect to the server node to enforce the time limit. Netplay is an Internet network system and therefore it equates to a server node. With respect to enforcing the time limit, the Examiner took official notice as explained above.

With respect to the official notice taken that to award click on coupons and to collect information.....to create profile, demographic and psychographic information and that it is well known to include branded questions in surveys and that it is well known to award points for prizes, since the Appellant didn't confirm, deny or command a response or request of such personal knowledge such as to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of, the Official notice is sustained. See MPEP 2144.03 where In re Boon is mentioned.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Raquel Alvarez  
Examiner  
Art Unit 3622

R.A.  
June 25, 2004

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